

**REMARKS**

Claims 1-7, 11-18 and 24-30 are pending. Claims 8-10 and 19-22 were previously cancelled.

Claims 1, 11, 23, 24, 30 have been amended in this response. New claims 31-34 have been added.

**Paragraphs 3 and 4 of the Office Action**

Claims 1, 2, 6, 11, 12, 16, 23, 27, and 30 have been rejected under 35 U.S.C. 102(b) as being anticipated by Heider (U.S. Patent 4,904,324).

As stated in the Office Action, Heider is directed to a method of in-mold labeling. In in-mold labeling, a label is positioned inside a mold used in a blow molding process where a hollow parison or preform is expanded against the walls of the mold to form a container so that that label comes into contact with the expanding parison or perform so that label is attached to the container as the container is being formed (see e.g., Heider col. 1, line 15 to col. 2, line 36).

In contrast, claims 1, 11, and 23 as amended are directed to the attachment of a metallic layer or label (hereinafter “layer/label”) to a pre-formed container (i.e., a pre-existing or previously formed container) and not to the attachment of a layer/label to a container during a process in which the container is formed such as the blow molding process set forth in Heider. Thus, the methods set forth in amended claims 1, 11, 23 are completely different than the in-mold labeling process discussed in the Heider. These limitations to amended claims 1, 11, and 23 are clearly set forth in Figs. 1, 3, and/or 4 of the present application. Simply nowhere in Heider is a process for attaching a metallic layer/label to a previously formed container as set forth in amended claims 1, 11 and 23 taught, disclosed or even suggested.

In addition, amended claim 1 requires that the metallic layer/layer be placed “directly against the external surface” of the container. This limitation is completely contradictory to the specification of Heider which only discloses a metallic film coating applied to the outer surface of the outer layer of the label before printing *merely* to provide a “metallic background for the printing” (see Heider col. 3, lines 38-41).

Amended claims 1, 11, and 23 further require that the metallic layer/label “act as a barrier to help prevent passage therethrough of contaminants into the container.” As previously stated above, Heider only discloses a metallic film coating applied to the outer surface of the outer layer of the label before printing for providing a “metallic background for the printing.” Heider simply provides no motivation or suggestion attaching a metallic layer/label to a pre-formed container for preventing contamination of items in the container from contaminants passing through the metallic layer/label.

Thus, for the reasons stated above, claims 1, 11, and 23 as amended are believed to patentable distinguishable from Heider, and therefore allowable over Heider. Claims 2 and 6 depend from amended claim 1, claims 12 and 16 depend from amended claim 11, and claims 27 and 30 depend from amended claim 23 and are, therefore, believed to be in condition for allowance by virtue of their dependency. Withdrawal of this rejection under 35 U.S.C. 102(b) is respectfully requested.

**Paragraph 5 of the Office Action**

Claims 1, 6, 11, 16, 17, 23, 25-27, and 30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka (U.S. Patent 5,254,302) in view of Heider and Yasuda et al. (U.S. Patent 5,409,754).

As stated in the Office Action, Yamanaka, Heider and Yasuda et al. are all directed to in-mold labeling. In contrast, as previously stated above, claims 1, 11, and 23 as amended are directed to the attachment of a metallic layer or label (hereinafter “layer/label”) to a pre-formed container (i.e., a pre-existing or previously formed container). Therefore, for the reasons previously set forth above, the methods set forth in amended claims 1, 11, 23 are completely different than the in-mold labeling process discussed in Yamanaka, Heider and Yasuda et al.

However, the Office Action also states that Yamanaka “teaches a second, iron-on labeling process for applying the label to the container comprising placing the label on the external surface of a preformed container and heating the label with an iron such that the heat from the [iron] melts the inner layer of the label and bonds the label to the container to form a labeled

container upon cooling (Column 1, lines 15-60)." This statement is completely contradictory to limitation in amended claim 1 which requires that the metallic layer/layer be placed "directly against the external surface" of the container.

Yamanaka, Heider and Yasuda et al. each (or in combination) also fail to teach, disclose, or suggest a metallic layer/label that acts "as a barrier to help prevent passage therethrough of contaminants into the container" as required by amended claims 1, 11 and 23 (and previously discussed above).

While the Office Action states that Yamanaka discloses the use of adhesive layers for in-mold labeling processes, it should be understood that Yamanaka does not provide any motivation for such adhesives in pre-form container labeling processes. Therefore, it is improper to make the conclusion that one skilled in the art of pre-form container labeling processes would readily appreciated use of such in-mold labeling adhesives in pre-form container labeling processes.

Thus, for the reasons stated above, claims 1, 11, and 23 as amended are believed to patentable distinguishable from Yamanaka in view of Heider and Yasuda et al. Heider, and therefore allowable. Claim 6 depends from amended claim 1, claims 16 and 17 depend from amended claim 11, and claims 25-27 and 30 depend from amended claim 23 and are, therefore, believed to be in condition for allowance by virtue of their dependency. Withdrawal of this rejection under 35 U.S.C. 103(a) is respectfully requested.

#### **Paragraph 6 of the Office Action**

According to the May 6, 2003 Office Action, claims 2-5 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka, Heider, and Yasuda et al. as applied above in paragraph 5, and further in view of the admitted prior art.

Claims 2-5 depend from amended claim 1, claims 12-15 depend from amended claim 11. For the reasons previously set forth above and by virtue of their dependency, these claims are now believe to be in condition for allowance. Withdrawal of this rejection under 35 U.S.C. 103(a) is respectfully requested.

**Paragraph 7 of the Office Action**

According to the May 6, 2003 Office Action, claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka, Heider, and Yasuda et al. as applied above in paragraph 5, and further in view of Kelch et al. (U.S. Patent 6,042,930).

Claim 7 depends from amended claim 1 and claim 18 depends from amended claim 11. For the reasons previously set forth above and by virtue of their dependency, these claims are now believed to be in condition for allowance. Withdrawal of this rejection under 35 U.S.C. 103(a) is respectfully requested.

**Paragraph 8 of the Office Action**

According to the May 6, 2003 Office Action, claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka, Heider, and Yasuda et al. as applied above in paragraph 5, and further in view of Yoda et al (U.S. Patent 3,961,009).

Claim 24 depends from amended claim 23. For the reasons previously set forth above and by virtue of their dependency, these claims are now believed to be in condition for allowance. Withdrawal of this rejection under 35 U.S.C. 103(a) is respectfully requested.

If for any reason an insufficient fee has been paid, the Examiner is hereby authorized to charge the insufficiency to Deposit Account No. 05-0150.

If the Examiner has any questions or needs any additional information, the Examiner is invited to telephone the undersigned attorney at (650) 843-3215.

Date: September 4, 2003

Respectfully submitted,

Squire, Sanders & Dempsey L.L.P.  
600 Hansen Way  
Palo Alto, CA 94304  
Telephone (650) 856-6500  
Facsimile (650) 843-8777

By: V.R.B  
Vidya R. Bhakar  
Attorney for Applicants  
Registration No. 42,323